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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,736	11/06/2001	Toshiki Kindo	P21671	4235

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RESTON, VA 20191

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,736

Applicant(s)

KINDO ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/3/05 & 2/6/2002
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1.1. Claims 9-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group of inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/18/2005

1.2. Applicant's election with traverse of claims 1-7 in the reply filed on 4/18/2005 is acknowledged. The examiner has considered the applicant's traversal fully but is not persuasive, except that examiner agrees to include the non-elected species including claim 8 with the elected claims 1-7 for examination. The applicant's traversal is on the ground(s) that there would not appear serious burden on the examiner in examining claims directed to non-elected species, since the search for the species identified would be coextensive or significantly overlap and the non-elected group of inventions II-V fall in the same class 705/26 as group I. This is not found persuasive because the (i) applicant has not responded to the reasoning provided in the previous office action for classifying the claims into 5 different groups and (b) the examiner disagrees with the applicant's assertion and states that while there may be some overlap between the search areas required for non-elected groups of claims, elected and withdrawn, the search is divergent.

The search for group III, claim 16 would additionally involve searching for the limitation, " merchandise information pieces are transferred from another consumer

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terminal with permission of the personal profile of stored in said storage section, said information filtering section ranks the merchandise information pieces based on the personal profile stored in said storage section to return to said another consumer terminal", which is just the opposite of what is required in combination group I.

Groups II and III, claims would require additional search for distributing information from the server corresponding to search criteria of the consumer", which is not required for Group I.

Group IV, claims 17-22 have a different utility than Group I because Group IV claims do not require (i) a distribution unit having a storage section to store the merchandise information provided by the sellers and (b) consumer terminals with a storage section for storing personal profiles and therefore would additionally involve searching for an invention different from Group I.

Group V, claims 23-25 have a different utility other than from Group I because in Group V the information filtering section is required to "rearranges the information" as against in Group I the information filtering section is required to : rank the information" and therefore would additionally involve searching for an invention different from Group.

Note: It is to be noted that patents claiming different inventions and requiring different search strategies do fall into same class/subclass, e.g. more than 1100 patents issued in 705/26.

Similarly, search required for claims falling in non-elected species is divergent. With reference to Group I, claim 9 requires receiving personal profile stored in another

consumer terminal, claims 10, 13 and 14 require assigning a specific mark, claims 11-12 does not require ranking based on personal profile stored in the storage section of **the another** consumer terminal but instead specifies ranking based on personal profile stored in the storage section of **one of said** consumer terminal, and all three limitations when added to claim 1 separately define distinct inventions requiring additional search other than required for species including claims 6-7.

The requirement is still deemed proper and is therefore made FINAL, except for including claim 8 with the elected group of claims and species. Currently claims 1-8 are pending for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.1. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document replete with "wherein clauses" and narration of intended use of system components, not providing a clear and definite understanding of the claimed invention. Claims 1-8 are directed to system claims and the analysis to distinguish them from the prior art should be on the basis structural elements rather than intended function. See

MPEP 2114 :Apparatus and Article Claims — Functional Language [R-1] .

APPARATUS CLAIMS MUST BE STRUCTU-RALLY DISTINGUISHABLE FROM THE PRIOR ART >While features of an apparatus may be recited either structurally or functionally, claims<directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (**The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference**); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). System claims 1-8 will be further treated on merits conforming to MPEP 2114 guidelines.

3. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1-3, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burge et al. (US Patent 6,014,638), hereinafter referred to Burge and further in view of Bellovin et al. (20010056409) hereinafter referred to Bellovin.

Regarding claim1, Burge discloses an e-commerce system comprising:

a merchandise information distribution unit having a merchandise information storage section that stores merchandise information pieces provided from a seller, and a merchandise information server that distributes the merchandise information pieces from said merchandise information storage section to a consumer (see col.4, line 30-col.5, line 47 and Fig.1, wherein the " Online Service Wide Area Network comprising network node computers 82, 88, host computer 84, database 86 corresponds to the claimed distribution unit including a storage section 86 that stores the merchandise information provided by the sellers.) ;

a plurality of consumer terminals each having a storage section that stores a personal profile with which various keywords contained in the merchandise information pieces and evaluation values corresponding to the keywords are registered, the evaluation values learned in advance based on a preference of a consumer, (see col.4, line 30-Fig.1, reference number "80" corresponds to a plurality of consumer terminals , each

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having a storage section which is capable of storing personal profile as claimed. Though Burge does not disclose the intended use of the personal profile, that is it includes registration of keywords and evaluation values, as analyzed above the analysis to distinguish the claimed limitations from the prior art of Burge should be on the basis of structural elements rather than intended function. However, the storage section, "80" in Burge is capable of storing a personal profile with which various keywords contained in the merchandise information pieces and evaluation values corresponding to the keywords are registered, the evaluation values learned in advance based on a preference of a consumer.) and an information filtering section that ranks the merchandise information pieces distributed from said merchandise information server to match the preference of the consumer, based on the personal profile, and wherein an order for merchandise from the merchandise information pieces distributed to one of said consumer terminals that places an order for merchandise using said e-commerce system is placed using the personal profile stored in said storage section in another one of said consumer terminals (see at least col.6, line1-col.10, line 26, Figs 2A and 2B, which disclose that a predictive model, which correspond to the claimed filtering section, ranks the sellers' merchandise to the preference of the consumer and suggests that the orders for merchandise are placed using the stored consumer's personal profile);

Burge discloses, as analyzed above making purchases and therefore it will be obvious to make payments to sellers and to charge the buyers for their purchases. Burge dose not disclose a clearing unit that withdraws a charge of merchandise from an account designated by the consumer to pay to the seller when receiving an order for

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merchandise from either of said consumer terminals. However, in the same endeavor for making and completing online transactions, Bellovin discloses a clearing unit that withdraws a charge of merchandise from an account designated by the consumer to pay to the seller when receiving an order for merchandise from either of said consumer terminals (see at least paragraph 0012). In view of Bellovin, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Burge to incorporate Bellovin's feature of using a clearing unit that withdraws a charge of merchandise from an account designated by the consumer to pay to the seller when receiving an order for merchandise from either of said consumer terminals because that will enable buyers to make payments using credit cards with the reduced possibility of misuse of their credit card numbers, as explicitly disclosed in Bellovin.

Regarding claims 2-3, and 6-8, they recite intended use of the distribution unit and information filtering section in transferring information and ranking the information, designating another terminal for ranking the information, defining another consumer as a celebrity and the intended use of keywords. Though Burge does not disclose these intended use and functional limitations, as analyzed above the analysis to distinguish the claimed limitations from the prior art of Burge/Bellovin should be on the basis of structural elements rather than intended function. However, the information distribution unit disclosed in Burge is capable of implementing the claimed intended uses and functions.

4.2. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burge/Bellovin and further in view of Toshiki et al. (Japanese Publication: JP 11-143900 received in IDS on 2/6/2002) hereinafter referred to Toshiki.

Reference claim 4, Burge/Bellovin, as analyzed above, discloses an e-commerce system for distributing seller's merchandise information to consumer terminals based on stored consumers' personal profiles. Burge/Bellovin does not disclose that the one of said consumer terminals has a querying section that queries whether the utilization of the personal profile stored in said storage section of the another one of said consumer terminals is permitted, said merchandise information distribution unit has a managing section which has utilization criteria registered therein of the personal profile stored in advance in said storage section of the another one of said consumer terminals, and which judges whether or not to permit the utilization of the personal profile stored in advance in said storage section of the another one of said consumer terminals when receiving the query from said querying section, and when said managing section permits the utilization of the personal profile stored in said storage section of the another one of said consumer terminals, the merchandise information pieces distributed to the one of said consumer terminals are transferred to said information filtering section of the another one of said consumer terminals. However, Toshiki discloses this limitation, [see at least abstract, " ... A user who utilizes an adaptive group information filter unit (FU) 56 sends an authentication signal to plural FUs 56 to 59.....by means of a group interface unit (GIU)55. The FUs 56 to 59 return an access approval or disapproval signal to the GIU 55 opensreads the paste

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records that the produced form recording parts 2,5 and6 ..that is written to an information storing part 41 and a signal that represents its reliability and shows need signals in order of a large one a display..."]. In view of Toshiki, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Burge/Bellovin to incorporate the features of Toshiki, that is including a querying section to take permission to use profile information stored in another computer which after evaluating decides to permit or not the use of stored personal profile in the other computer because it will ensure sharing data of other personal profiles subject to proper authorization, as explicitly disclosed in Toshiki.

Regarding claim 5 I recites intended use of the distribution unit and clearing unit in withdrawing an utilization charge from the user's designated account, while paying the utilization charge to another terminal which provides the information. Though Burge does not disclose these intended use and functional limitations, as analyzed above the analysis to distinguish the claimed limitations from the prior art of Burge/Bellovin/Toshiki should be on the basis of structural elements rather than intended function. However, the information distribution unit disclosed in Burge/Bellovin/Toshiki is capable of implementing the claimed intended uses and functions.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(i) US patents 6,363,383 & 6,687,703 to Kindo et al. (see abstract) teach a method and system for restricted access of information pieces from another storage medium based upon the judgment of an information manager.

(ii) US Patent 6,236,990 to Geller et al. (see at least abstract) discloses a method and a system for ranking multiple products according to user's preferences in assisting a user to select a product from multiple products.

(iii) US Patent 6,820,204 to Desai et al. (see at least abstract) teaches a system and method for allowing users with control to share real-time user profile information via Internet, wherein the profile information.

(iv) US Patent 6,839,680 to Liu et al. (see at least abstract and col. 2, lines 14-61) teaches a system and method for tracking and aggregating personal profiles that describes the user's interests over time and using these aggregated profiles to market information and products to the user, wherein the profiles are stored allowing users with

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control to share real-time user profile information via Internet, wherein the profile information is collected both on the server and client .

(v) US Patent 5,872,850 to Klein et al. discloses a system and method for enabling a marketplace wherein a server stores data in a memory and when accessed by a node for using stored data it permits access to the node based upon stored information in relation to the requesting node (see at least abstract).

(vi) US Patent 6,591,300 to Yurkovic discloses a computer network based system/method for integrating group related information from a plurality of sources, thereby allowing group members to access and view information entered by other group members from an integrated database (see abstract) .

(vii) US Patent 6,330,610 to Doctor et al. discloses a data filtering system that filters data per filter criteria in multiple stages (see abstract).

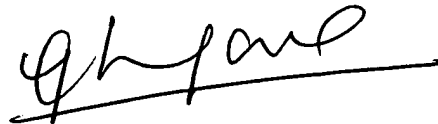
(viii) US Patent 6,006,332 to Rabne et al. discloses a system for controlling access to stored digitized data (see abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Yogesh C Garg', with a long horizontal line extending from the end of the signature.

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
May 26, 2005